

REMARKS

At the time of this response, claims 1-20 are pending. Claims 6 and 16 are currently amended and claims 1-5, 7-15 and 17-20 appear as originally or previously presented. The Applicant respectfully traverses the 35 USC §§ 112, and 103 rejections set forth in the OA, which should be withdrawn for the reasons set forth below.

I. Preliminary Matters

The OA rejected claims 1-20 under 35 U.S.C. § 103(a) using U.S. Patent No. 7,039,697 to Bayles (Bayles) and/or U.S. Patent Application Publication No. 2002/0138291 to Vaidyanathan et al. (Vaidianathan) as primary references. Substantially identical references from Bayles and Vaidyanathan, discussed in the responses below, were used for rejecting claims 1-20 in the First Office Action on the Merits dated February 8, 2007 (FAOM), The Final Office Action dated August 9, 2007 (Final OA) and the current OA, which was in response to an Appeal Brief filed by the Applicant on January 16, 2008 (Appeal Brief).

The OA does not follow the instruction in MPEP 706.07 that “[i]f appeal is taken in such a case, the examiner’s answer should contain a complete statement of the examiner’s position,” and has failed to “properly communicate the basis for a rejection so that the issues can be identified” or “clearly explain the rationale for decisions made during prosecution,” according to MPEP 706.02(j).

The OA states on page 2 (shown as Exhibit 1 below) that the Examiner agrees with the Applicant’s arguments. The “Response to Arguments” section contains a previously asserted, responded to, unresolved and outstanding argument, analyzed in detail in section IV below. Otherwise, the OA contains no complete statement of the Examiner’s position as required by MPEP 706.07. If the Examiner agrees with the Applicant’s arguments, the Applicant respectfully requests the allowance of claims 1-20, or a more detailed statement of the Examiner’s position according to MPEP 706.07 beyond simply repeating previously presented arguments. Specifically, the Applicant respectfully requests an analysis of which arguments the Examiner agrees with, and why agreement with such arguments does not merit allowance of claims 1-20.

After further review of the appeal brief during an appeal brief conference, Examiner agreed with Applicant's argument, therefore have decided to reopen prosecution.

Exhibit 1: OA, Page 2, Paragraph 1 (emphasis added)

MPEP 2141 and its supporting case law (shown below as Exhibit 2), direct office personnel to reconsider any initial obviousness determination in view of the entire record. This directive was not observed in the current OA. Multiple responses previously presented, and noted in their analysis in section IV below, were overlooked and not addressed in the “Response to Arguments” section beginning on page 10 of the OA. Also, as previously mentioned, the “Response to Arguments” section includes only one argument, asserted in the last paragraph of Page 10 of the OA, and repeated using almost identical language in the first paragraph of Page 11 of the OA.

The Applicant respectfully submits that, by overlooking previous assertions, and repeating a responded to, but unresolved argument, the OA does not contain a complete statement of the Examiner's position, properly communicate the basis for a rejection, or clearly explain the rationale for decisions made during prosecution as required and previously discussed.

Once the applicant has presented rebuttal evidence, Office personnel should reconsider any initial obviousness determination in view of the entire record. See e.g., *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Eli Lilly & Co.*, 90 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). All the rejections of record and proposed rejections *and their bases* should be reviewed to confirm their continued viability. The Office action *should clearly communicate the Office's findings and conclusions*, articulating how the conclusions are supported by the findings.

Exhibit 2: MPEP 2141 V. CONSIDERATION OF APPLICANT'S REBUTTAL EVIDENCE (emphasis added)

II. Claim Rejections – 35 USC § 112

The OA rejected claims 6 and 16 under 35 USC § 112 on the basis that “the phrase ‘adapted for’ renders the claim indefinite” (OA, p. 2, paragraph 4). Without agreeing with the OA’s rejections, claims 6 and 16 are hereby amended to overcome the stated rejections. Claims 6 and 16, as amended, remove the word “adapted” in order to render the claim definite.

III. Claim Rejections – 35 USC § 103

A. Claims 1-5 and 11-15 (Bayles + Vaidyanathan + Toda)

The OA rejected claims 1-5 and 11-15 under 35 U.S.C. § 103(a) as being unpatentable over Bayles in view of Vaidyanathan in further view of U.S. Patent Application Publication No. 2002/0138291 to Toda et al. (Toda). MPEP 706.07 cautions against the use of such new references as seen in Exhibit 3 below. The Applicant also respectfully traverses these rejections because the OA fails to establish *prima facie* obviousness.

Switching from ... one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

Exhibit 3: Excerpt from MPEP 706.07

1. Bayles, Vaidyanathan and Toda do not show the claimed limitations.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03; *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, all words in a claim must be considered in judging the patentability of that claim against the prior art. MPEP § 2143.03; *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). For the reasons set forth in detail below, The Applicant submits that the claimed limitations are neither taught nor suggested by the cited prior art, thus claims 1-5 and 11-15 are patentable over the prior art under § 103.

Bayles in view of Vaidyanathan in further view of Toda do not disclose nor suggests all of the claimed limitations. The OA states that Bayles and Vaidyanathan fail to teach that at least one of the plurality of Customers was guided (OA p. 4, line 6). The Applicant agrees with this assessment. However, the OA does not consider the invention as a whole (discussed in more detail below) in its obviousness rejection, and when the invention as a whole is considered, element E) of both claims 1 and 11 are not shown in the prior art.

Element E) of both claim 1 and claim 11, relate to a Customer being guided to a web site that registered a domain name. This limitation is neither taught nor suggested anywhere in any of the prior art references, either individually or in combination.

The OA does not show the disclosure of all claimed limitations, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

2. Toda teaches away from the other references and the present invention.

A *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997). If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Toda teaches away from the present invention. Claims 1 and 11 of the Applicant's current invention involve a Customer being guided to a web site that registered a domain name. Ignoring for the moment the fact that nowhere in Toda is a Customer guided to a web site that registered a domain name, the cited portion of Toda, paragraph [0045] discloses "a user who ... loses his or her way in the Web site and sends a guidance information ... to arrive at the desired goal page" Thus, the Applicant's current invention claims a customer being guided to a website and Toda teaches monitoring a user being guided to a page within a website.

This is a critical distinction because Toda only discloses monitoring and guiding a user to pages within a single web site. For a user to be guided to either the web site taught in Bayles, or the digital file marketplace taught in Vaidyanathan, the user would have to be guided away from the single monitored web site taught in Toda thereby losing the ability to monitor or guide users to appropriate pages within the web site accordingly.

The OA combines references that teach away from each other and the Applicant's claimed invention, and modify references in such a way as to make the modified invention unsatisfactory for its intended purpose, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

3. The OA fails to consider the claimed invention as a whole.

In determining the differences between the prior art and the claims, the question under § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. MPEP § 2141.02. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983). Furthermore, distilling an invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” MPEP § 2141.02. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The Applicant respectfully submits that the OA erroneously disregards the subject invention as a whole by distilling it to the “gist” of the systems and methods shown in the prior art without showing: (1) the presence of each limitation in the prior art; and (2) establishing the “obviousness” of the invention as a whole.

Specifically, the OA completely fails to show (via citations to prior art or a showing of obviousness) one of the core novelties of the subject invention – a Customer being guided to a web site that registered a domain name. When the claimed invention (including this core novelty) is considered as a whole it becomes clear that it is not obvious over the prior art.

The OA does not consider the claimed invention as a whole, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

4. Bayles, Vaidyanathan and Toda are Non-Analogous Art.

To show that the references are analogous “the similarities and differences in structure and function of the inventions” must be analyzed. See *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973). Furthermore MPEP 2141.01(a) requires analogous prior art to either be in the same field of endeavor or pertinent to the problem to be solved.

Bayles, Vaidyanathan and Toda are all from different fields of endeavor. Bayles “pertains to distributed computer network node naming resolution processes.” (Bayles, col. 1 lines 24-25). Vaidyanathan, by the Examiner’s own admission (OA, p. 4, lines 7-13; p. 7 last paragraph; p. 10 last paragraph – p. 11 first paragraph) “relates to a digital file(s) marketplace.” (Vaidyanathan

[0002]) Toda, by the Examiner's own admission (OA, p. 4, last two lines), "relates to a site monitoring method." (Toda [0002]). None of these references are within the same field of endeavor, and the OA provides no link to show a relationship of fields of endeavor with the three references.

In addition, none of the references are pertinent to the problem the others are trying to solve. For example, a computer node naming resolution process is irrelevant to the problems solved by a digital file marketplace. Likewise, a digital file marketplace is not pertinent to problems solved by a site monitoring method.

Finally, none of the references are in the field of endeavor or pertinent to the problem solved by a Customer being guided to a website that registered a domain name. The references are therefore non-analogous art.

The OA does not combine references from analogous art, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

5. The prior art references are combined using impermissible hindsight.

MPEP 2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." The OA's reasoning for combining the prior art (shown below as exhibits 4 and 5) are conclusory statements in the OA that the claimed invention "as a whole" would have been obvious at that time to that person. Such conclusory statements ignore the directive in MPEP 2145 that "[k]nowledge of applicant's disclosure must be put aside in reaching this determination."

The assertions above demonstrate this principle. It would not have been obvious to one of ordinary skill in the art at the time of the invention, independent of hindsight reasoning, to modify Bayles in view of Vaidyanathan to provide means for compensating each Reseller that guided a Customer *to the registrar web site that registered a domain name*, since that limitation is not found in any of the cited prior art, and the references from Bayles and Vaidyanathan do not consider the claimed invention as a whole.

Furthermore, the OA justifies the combination of Bayles and Vaidyanathan "to allow maintaining a third party website." The maintenance of third party web sites is not a limitation in claims 1-5 or 11-15. The OA explicitly and impliedly admits that no such means for maintaining

a third party website is taught in either Bayles or Vaidyanathan (*See* OA, p. 7, line 3). It appears that this reasoning has been copied and pasted from a previous office action, creating a logical non-sequitur in the motivation for the combination of the references. Thus, the reasoning for combining Bayles with Vaidyanathan in the *current* OA is no longer relevant to the issues being argued. As such, no *valid* reason to combine Bayles with Vaidyanathan has been provided in the OA, and claims 1-5 and 11-15 should be allowed at least for this reason.

It would also not have been obvious to combine Bayles and Vaidyanathan in view of Toda to provide at least one of the plurality of Customers was *guided to the registrar web site* from actions by one of the plurality of Resellers. Toda teaches away from guiding to any web site, but rather guiding to pages within a single monitored web site, and thus to be guided away from such a web site would render the combination unsatisfactory for its intended purpose.

The OA combines references using impermissible hindsight, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bayles in view of Vaid to provide means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name. One would be motivated to do so to allow maintaining the third party website.

Exhibit 4: OA Page 4, lines 14-18

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bayles and Vaid in view of Toda to provide at least one of the plurality of Customers was guided to the registrar web site from actions by one of the plurality of Resellers. One would be motivated to do so to allow guiding the user to the desired web page (abstract).

Exhibit 5: OA Page 5, lines 1-5

6. Dependent claims should be allowable based on allowable parent claims.

Claims 2-5 and 12-15 depends upon claims 1 and 11 respectively, which are believed to be allowable. Claims 2-5 and 12-15 should therefore be allowed.

B. Claims 6-10 and 16-20, as amended (Bayles + Wilson + Vaidyanathan)

The OA rejected claims 6-10 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Bayles in view of U.S. Patent No. 7,007,080 to Wilson (Wilson) in further view of

Vaidyanathan. The Applicant respectfully traverses these rejections because the OA fails to establish *prima facie* obviousness.

1. Bayles, Wilson and Vaidyanathan do not show the claimed limitations.

As shown in section I(A)(1) above, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art and all words in a claim must be considered in judging the patentability of that claim against the prior art. For the reasons set forth in detail below, the Applicant submits that the claimed limitations are neither taught nor suggested by the cited prior art, thus claims 6-10 and 16-20 are patentable over the prior art under § 103.

Bayles in view of Wilson in further view of Vaidyanathan do not disclose nor suggests all of the claimed limitations. The OA states that Bayles fails to teach an administration web site (OA p. 7, line 3) and that Bayles and Wilson fail to teach selling products or services to a Customer of the Reseller and compensating the Reseller (OA p. 7, lines 13-14). The Applicant agrees with this assessment. However, the OA does not consider the invention as a whole in its obviousness rejection (discussed in more detail below), and when the invention as a whole is considered, element B) of both claims 6 and 16 are not shown in the prior art.

Element B) of both claim 6 and claim 16 as amended, relate to an administration web site for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their customers. This limitation is neither taught nor suggested anywhere in any of the prior art references, either individually or in combination.

The OA does not show disclosure of all claimed limitations, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 6-10 and 16-20.

2. "Administration web site" has a different meaning to one skilled in the art.

The "hypothetical 'person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988).

The “administration web site” disclosed in the cited portion of Wilson does not consider the meaning of the term to one of ordinary skill in the art as such a person would have considered limitation B) in claims 6 and 16 at the time of the invention. In addition to allowing Resellers to enter the reseller program, the purpose of such a web site is explicitly claimed “to customize the registrar web site” as would have been recognized by a person having ordinary skill in the art at the time of the invention.

By contrast, the cited portion of Wilson (col. 5, lines 7-8) relates to administration of network access resources in multiple unit buildings such as hotels. The cited portion of Wilson is the only portion of the reference where the words “administration” and “web site” appear anywhere within proximity of one another. The administration in this passage refers only to a web site for administration of connections to the network and their relationship to hotel guest registration and not to an administration web site for allowing a user to customize web sites, as the term is commonly used in the art and explicitly claimed in the current invention.

The OA does not consider the use of the phrase “administration web site” as claimed and as the meaning of the term is used by one of ordinary skill in the art, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 6-10 and 16-20.

3. Wilson teaches away from the other references and the present invention.

As previously shown in section I(A)(2) above, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Wilson teaches away from the present invention. Claims 6 and 16 of the current invention involve an administration web site for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their customers. The paragraph following the cited portion of Wilson (col. 5 lines 11-19) disclose that the “system is a server-only solution and ... is designed to operate without modifications.”

This is a sharp contrast to an administration web site whose very purpose is to *modify and customize the registrar web site for their customers*. The OA combines references that teach

away from each other and the claimed invention, and modify references in such a way as to make the modified invention unsatisfactory for its intended purpose, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 6-10 and 16-20.

4. The OA fails to consider the claimed invention as a whole.

As shown in section I(A)(3) above, in determining the differences between the prior art and the claims, the question under § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Furthermore, distilling an invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.”

The Applicant respectfully submits that the OA erroneously disregards the subject invention as a whole by distilling it to the “gist” of the systems and methods shown in the prior art without showing: (1) the presence of each limitation in the prior art; and (2) establishing the “obviousness” of the invention as a whole.

Specifically, the OA completely fails to show (via citations to prior art or a showing of obviousness) one of the core novelties of the subject invention – an administration web site for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their customers. When the claimed invention (including this core novelty) is considered as a whole it becomes clear that it is not obvious over the prior art.

The OA does not consider the claimed invention as a whole, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 6-10 and 16-20.

5. Bayles, Wilson and Vaidyanathan are Non-Analogous Art.

As shown in section I(A)(4) above, to show that the references are analogous “the similarities and differences in structure and function of the inventions” must be analyzed. Furthermore analogous prior art must either be in the same field of endeavor or pertinent to the problem to be solved.

Bayles, Wilson and Vaidyanathan are all from different fields of endeavor. Bayles “pertains to distributed computer network node naming resolution processes.” (Bayles, col. 1

lines 24-25). Wilson, by the Examiner's own admission, "teaches system for reconfiguring and registering a new IP address for a computer to access a different network without user intervention." (OA, p. 7, lines 4-5). Vaidyanathan, by the Examiner's own admission (OA, p. 4, lines 7-13; p. 7 last paragraph; p. 10 last paragraph - p. 11 first paragraph) "relates to a digital file(s) marketplace." (Vaidyanathan [0002]). None of these references are within the same field of endeavor, and the OA provides no link to show a relationship of fields of endeavor with the three references.

In addition, none of the references are pertinent to the problem the others are trying to solve. For example, a computer node naming resolution process is irrelevant to the problems solved by a system for reconfiguring and registering a new IP address for a computer to access a different network without user intervention. Likewise, a system for reconfiguring and registering a new IP address for a computer to access a different network without user intervention is not pertinent to the problems solved by a digital file marketplace.

Finally, none of the references are in the field of endeavor or pertinent to the problem solved by an administration web site for allowing Resellers to enter the reseller program and allowing each Reseller to customize the registrar web site for their customers. The references are therefore non-analogous art.

The OA does not combine references from analogous art, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 6-10 and 16-20.

6. The prior art references are combined using impermissible hindsight.

Section I(A)(5) above shows that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." The OA's reasoning for combining the prior art (shown below as exhibit 6) is a conclusory statement in the OA that the claimed invention "as a whole" would have been obvious at that time to that person. Such conclusory statements ignore the directive in MPEP 2145 that "[k]nowledge of applicant's disclosure must be put aside in reaching this determination."

The assertions above demonstrate this principle. It would not have been obvious to one of ordinary skill in the art at the time of the invention, independent of hindsight reasoning, to combine Bayles in view of Wilson to provide an administration web site *for allowing Resellers*

to enter the turnkey reseller program and allowing each Reseller to customize the registrar web site for their Customers, since that limitation is not found in any of the cited prior art, the administration web site is not used as understood in the art and the references from Bayles and Wilson do not consider the claimed invention as a whole.

The OA combines references using impermissible hindsight, thus failing to establish a *prima facie* case of obviousness. The Applicant therefore respectfully requests the allowance of claims 1-5 and 11-15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Bayles in view of Wilson to provide B) creating an administration web site adapted for allowing Resellers to enter the turnkey reseller program and allowing each Reseller to customize the registrar web site for their Customers. One would be motivated to do so to allow monitoring who is connected and registered to the network.

Exhibit 6: OA Page 7, lines 7-12

7. Dependent claims should be allowable based on allowable parent claims.

Claims 7-10 and 17-20 depends upon claims 6 and 16 respectively, which are believed to be allowable. Claims 7-10 and 17-20 should therefore be allowed.

IV. Response to Arguments

All assertions presented in section I above apply in an analysis of the OA's "Response to Arguments" section. This section does not contain a complete statement of the Examiner's position, properly communicate the basis for a rejection, or clearly explain the rationale for decisions made during prosecution as required and previously discussed in section I above.

The substance and references which support the "Response to Arguments" section has been presented in the FAOM, the Final OA and repeatedly in the current OA. The Applicant has responded accordingly in each response, the most comprehensive response from the Appeal Brief is shown below as exhibit 7. No rebuttal argument has been presented to this or additional assertions presented below in the Final OA or the current OA.

In addition, the Appeal Brief specifically addressed the issue of lack of response and reproducing text cited in a previous rejection in section VII(C)(1)(c) (shown as Exhibit 8 below). This argument, ironically, was overlooked in the current OA. The Applicant therefore restates this assertion, not only for the "Response to Arguments" section but regarding the following

overlooked portions of previous responses as well. The Applicant respectfully submits that the lack of response and repetition of previously cited text with no complete statement of the Examiner's position, no basis for a rejection and no clear explanation of the rationale for decisions made during prosecution constitutes reversible error and requests the allowance of claims 1-20.

b. Element E

Vaidyanathan does not teach means for compensating each Reseller that guided a Customer to the registrar web site that registered a domain name. The Final OA states that **Vaidyanathan** teaches *"means for compensating each Reseller that guided a customer to the registrar web site that registered a domain name."* (Final OA page 4, lines 14-16; shown below as Image 4). The relevant references within **Vaidyanathan** cited in the Final OA (Figure 2; shown below as Image 5, and Paragraph [0019] shown below as Image 6) do not teach means for compensating each Reseller that guided a Customer to a registrar web site that registered a domain name as stated in the Final OA on page 4. As a preliminary matter, **Vaidyanathan** does not even disclose a "registrar web site" or registering a "domain name." In addition, there is no mention of a Reseller that "guided" a Customer anywhere, let alone a registrar web site.

Exhibit 7: Appeal Brief, Page 14 last paragraph – Page 15, first paragraph

c. Failure to respond

MPEP 707.07(f) directs that the Examiner *"take note of the applicant's argument and answer the substance of it"* The argument in the previous section b was presented in response to the Non-Final OA. However, the Examiner's only response to this argument was to restate the content of Paragraph [0019], and restate the Examiner's previous argument.

It is respectfully submitted that reproducing the text cited in a rejection, and the text of the rejection itself does not constitute a *"clear explanation of all actions taken by the examiner during the prosecution of an application"* as required by MPEP 707.07(f). The Appellants respectfully submit that the Examiner's lack of response in this issue constitutes reversible error and requests the allowance of claims 1-20.

Exhibit 8: Appeal Brief, Page 21 last paragraph – page 22 first paragraph

The OA similarly overlooked arguments regarding the scope of the prior art and instances of the prior art teaching away from additional references and the claimed invention in sections VII(C)(1)(a) and VII(C)(1)(b) of the Appeal Brief, shown below as Exhibits 9 and 10 respectively. The Applicant respectfully requests a response to these and any other previously presented assertions that have been overlooked.

a. Compensating resellers

The Examiner states that *"Bayles fails to teach explicitly E) means for compensating each Reseller that guided a Customer to the registrar web site."* The Appellants agree with this analysis. However, the most relevant portion of the **Vaidyanathan** citation (Paragraph [0019]; shown as Image 6 above) merely teaches *"when the consumer 16 downloads a file 12, the consumer 16 is charged the retail price set by the owner. The transaction fee charged by the marketplace and any reseller commission is then subtracted from the retail price collected from the consumer 16."* This is a means of compensating resellers known in the art, but does not teach *"compensating each Reseller that guided a Customer to the ... web site."*

Exhibit 9: Appeal Brief, Page 14 last paragraph – Page 15, first paragraph

b. Relevant teachings teach away from claimed matter

Instead of guiding Customers to a registrar web site, **Vaidyanathan** teaches downloading files from the Resellers' own web sites. This can be seen in **Vaidyanathan's** abstract (second to last sentence; shown below as Image 10) where it states *"[i]f the second user [Customer] downloads the particular file from the third party website [Reseller's website], then the first user [Reseller] is paid the reseller commission set for the file"* In addition, the last sentence in paragraph [0017] (shown below as Image 11) states *"[r]esellers are third parties who also offer the files 12 to the public on a third party website."* Thus, Resellers are paid for downloading files to Customers from their own web sites, not for guiding Customers to a registrar web site.

Therefore, not only does **Vaidyanathan** fail to teach guiding customers to a registrar web site, it teaches away from claims 1 and 11 by teaching the process of downloading files to its Customers from the Resellers' own third party web site. Simply put, Resellers downloading files to Customers from their own web sites does not teach the claim limitation of Resellers guiding Customers to a registrar web site. Thus, not every element in claims 1 and 11 (and their dependent claims 2-5 and 12-15) is disclosed, therefore claims 1-5 and 11-15 should be allowed.

Exhibit 10: Appeal Brief, Page 21 last 3 lines – page 22 first 7 lines

The OA does not contain a complete statement of the Examiner's position, properly communicate the basis for a rejection, and/or clearly explain the rationale for decisions made during prosecution. The Applicant therefore respectfully requests the allowance of claims 1-20.

CONCLUSION

All claims currently present in this application are believed allowable over all of the art of record and prompt further examination of the application and its allowance are respectfully requested.

Any questions or suggestions regarding the application or the amended claims submitted herewith should be directed to the undersigned attorneys for the Applicant at the telephone number listed below or by email to the email address listed below.

No fees are believed necessary. However, authorization is given to charge any additional fees associated with this communication to Go Daddy's deposit account No. 503134.

Respectfully submitted,

The Go Daddy Group, Inc.

Date: 10/9/2008

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